

REMARKS

I. Status of the Application and Claims

With entry of this amendment to claim 55, claims 19-81 are pending in the application. All claims have been rejected. Support for the amendment to claim 55 is found in the original specification as-filed and in all priority applications, for example, in the original as-filed specification in claim 14. This amendment introduces no new matter, and requires no additional search.

II. Indefiniteness Rejection of Claim 55

The Office rejected claim 55 under 35 U.S.C. § 112, second paragraph, as being indefinite because "it is not clear whether the term '18-methyleicosanoic acid' is a claimed limitation." Office Action at page 3.

Applicants disagree with the rejection. In order to promote the prosecution of the application, however, Applicants amend claim 55 solely to more particularly describe the subject matter of the invention. Support for the amended claim is found, for example, in the original as-filed specification in claim 14. No new matter has been added.

Applicants respectfully request reconsideration and withdrawal of the rejection.

III. Rejections under 35 U.S.C. § 103(a)

Maubru in view of *Bergmann* and *Dubief-B*

The Office again rejected claims 19-29, 32-54, and 56-81 under 35 USC§ 103(a) as being obvious over *Maubru* (U.S. Patent No. 6,312,674 B1) ("*Maubru*") in view of *Bergmann* (U.S. Patent No. 6,110,450) ("*Bergmann*") and *Dubief* (U.S. Patent No. 6,120,757) ("*Dubief-B*") for the reasons set forth on pages 3-5 of the Office Action. Applicants traverse the rejection for reasons of record and as supplemented below.

To establish a prima facie case of obviousness, the Office must meet three basic criteria, including that, there must be some motivation to combine the references, other than from the Applicants' own specification. See M.P.E.P. § 2143. In the present case, the Office has failed to make a prima facie case of obviousness because at least this criterion has not been met.

When the Office relies on a combination of references, it can satisfy the burden of obviousness "only by showing some objective teaching [*leading to the combination*]." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added). Moreover, under U.S. law, to establish a prima facie case of obviousness the Office must establish the motivation by "substantial evidence" provided on the record. In the present case, the Office has not satisfied this burden. The Office states "given the general teaching in *Maubru* that conventional additives for oxidizing composition for hair can be employed, it would have been obvious to...have looked to the prior arts such as *Bergmann* and *Restle* for specific additives such as fatty alcohol and quaternary ammonium surfactants." Office Action, page 5. Modifying the references by merely selecting certain possible components from each reference

to devise the composition of the claimed invention, without further motivation in the art, is an insufficient basis for maintaining a prima facie case of obviousness.

The Office alleges that:

The motivation to combine the ingredients to successfully formulate a hair composition for topical application is found in the teachings [of] the prior arts that these are old and well known for hair treatment purposes. See In re Kerkhoven. Nothing nonobvious or unexpected is seen in combining conventional ingredients used for the same purposes. See MPEP § 718.02.

Office Action, page 5. Applicants disagree with the Office's reliance on *Kerkhoven*, introduced in this case by the Office only in the final Office Action dated April 9, 2003, as a short cut means to establishing a prima facie case of obviousness without first establishing the elements of a prima facie case as required by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Further, as discussed below, Applicants submit that *Kerkhoven* has been improperly relied upon, and does not support the Office's position.

First, the facts and holding of *Kerkhoven* involved "combin[ing] two compositions each of which is taught by the prior art to be useful for the same purpose." *In re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980) (emphasis added). However, in contrast to *Kerkhoven*, in the present case the Office does not appear to be combining compositions. Rather, in an effort to reproduce Applicants' claimed invention, the Office is picking and choosing individual components from isolated disclosures in the cited references. However, "[s]uch piecemeal reconstruction of the prior art patents in light of [Applicants'] disclosure is contrary to the requirements of 35 U.S.C. 103." *In re Wesslan*, 147 USPQ 391, 393 (CCPA 1965).

Indeed, in order to properly apply *Kerkhoven*, the combination from the three cited references would be: one or more oxidation compositions comprising a ceramide, where the preceding are from *Maubru*; and then from *Bergmann*, at least one ceramide or cationic polymer, phytantriol, and then from *Dubief-B*, at least one quaternary ammonium surfactant. This combination is not the combination made by the Office and therefore *Kerkhoven* is misapplied.

Further, if the Office is suggesting the combination of compositions, Applicants submit that the Office has no evidence from which it can predict the outcome of such a combination, or have a reasonable expectation of success for the combination. In fact, it is known that dye components can interact to affect the properties of the composition unpredictably, including its toxicity. For example, in C. Zviak, *The Science of Hair Care*, Marcel Kekker, Inc., p. 329 (1986), Zviak explains that, with respect to the safety of finished products, “[a]ll finished cosmetic products must be evaluated for safety in use to make sure that they do not, under normal and foreseeable conditions, constitute a potential hazard for the consumer....” Zviak explains that such testing is not easily accomplished due to unpredictable component interactions. Specifically, “[i]t might seem that a sensible way of proceeding would be to conduct most toxicological tests on the ingredients, which would reduce the amount of experimentation and cost of developing finished products. However, experience has shown that the formulation itself is the important element. It determines local tolerance after a single or repeated application, eye and/ or lung mucosa tolerance, the degree of absorption through the skin, etc.” *Id.* Further, according to Zviak, synergistic effects that make a product more or less toxic may occur. That is, “[a]part from the effect of the vehicle, it has been observed

that the association of different compounds can product either synergistic toxicity or, on the contrary, a mitigation or even inhibition of toxic effects.” *Id.*

The Office’s conclusory statements are not adequate grounds for a rejection based on obviousness. “[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998). Indeed, the Office can satisfy the burden of showing obviousness “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992).

In this case, the Office has not provided an adequate explanation of why it would have been allegedly obvious to combine the teachings of *Maubru*, *Bergmann*, and *Dubief-B*. Here, the combination fails to provide the requisite motivation necessary to support a prima facie case of obviousness because it does not teach or suggest the inclusion of any ceramide with a quaternary ammonium surfactant in an oxidizing composition. Further, there would have been no reasonable expectation of success for such a combination because *Maubru* does not disclose the utility of ceramides in an oxidizing composition in combination with a quaternary ammonium surfactant, or any surfactants for that matter.

In response to Applicants previous arguments the Office alleges:

[T]he *Bergmann* reference teaches in col. 6, lines 58-62, to use “natural, hydrogenated or unhydrogenated, synthetic or non-synthetic hydrocarbon oils which are cyclic or aliphatic, linear or branched, saturated or unsaturated and soluble or insoluble, fatty alcohols”. In

view of this suggestion, examiner takes the position that the selection of liquid fatty alcohol in this case is obvious.

Id. page 6, emphasis added. Applicants disagree with the Office interpretation of what is allegedly disclosed at col. 6, lines 58-62.

Bergmann specifically describes "hydrocarbon oils which are cyclic or aliphatic, linear or branched, saturated or unsaturated." Applicants submit that the disclosure at col. 6, lines 58-62, to "cyclic or aliphatic, linear or branched, saturated or unsaturated" is relative only to "hydrocarbon oils" and is not relative to fatty alcohols. Further, Applicants point out that prior art cosmetic compositions were known to add solid fatty alcohol generally to improve the stability of compositions, for example, due to fatty alcohol's known emulsifying and thickening properties. Specification, page 2, lines 21-23. The Applicants, however, have discovered that addition of at least one liquid fatty alcohol in combination with ceramide-type compounds results in stable liquid compositions which exhibit substantial improvement in cosmetic performance on both wet hair and on dry hair. *Id.*, page 2, lines 10-16. There is no evidence of record for making such a composition and neither is there evidence that such a composition would be stable and provide improved performance on hair. Therefore, Applicants' discovery provides additional evidence that one of ordinary skill in the art at the time of invention would not have been motivated by *Bergmann* to add liquid fatty alcohol as proposed by the Office.

Applicants request reconsideration and withdrawal of the rejection.

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Maubru in view of Bergmann, Dubief-B, and Critchley

The Office again rejected claims 30 and 31 under 35 USC § 103(a) as being obvious over *Maubru* in view of *Bergmann, Dubief-B* as applied to claims 19-29, 32-54, and 56-81 above, and further in view of *Critchley* (U.S. Patent No. 5,198,210) ("*Critchley*") for the reasons set forth on page 5 of the Office Action. Applicants respectfully traverse the rejection for reasons of record and as supplemented below.

For the reasons set forth above, Appellants submit that claims 30 and 31 are also patentable over *Maubru* in view of *Bergmann, Dubief-B* as applied to claims 19-29, 32-54, and 56-81, and further in view of *Critchley*. *Critchley* is only cited as teaching compositions containing emollients such as isocetyl alcohol, stearyl alcohol, and cetyl alcohol. *Id.* The remaining three references are applied against these claims as in the rejection discussed above. As Applicants have noted, the Office has identified no evidence of a teaching, suggestion, or motivation to combine those references. *Critchley* does not cure this deficiency.

Applicants respectfully request reconsideration and withdrawal of the rejection.

Maubru in view of Bergmann, Dubief-B, and Ochiai

The Office rejected claims 55 under 35 USC § 103(a) as being obvious over *Maubru* in view of *Bergmann, Dubief-B* as applied to claims 19-29, 32-54, and 56-81 above, and further in view of *Ochiai* (U.S. Patent No. 5,587,155) ("*Ochiai*") for the reasons set forth on page 6 of the Office Action. Applicants disagree with the Office's position. For the reasons set forth above, Applicants submit that claim 55 is also patentable over *Maubru* in view of *Bergmann, Dubief-B* as applied to claims 19-29, 32-54, and 56-81, and further in view of *Ochiai*.

Ochiai is only cited as teaching hair conditioning compositions containing 18-methyleicosanoic acid. *Id.* The remaining three references are applied against this claim as in the rejection discussed above. As Applicants have noted, the Office has identified no evidence of a teaching, suggestion, or motivation to combine those references. *Ochiai* does not cure this deficiency.

Applicants respectfully request reconsideration and withdrawal of the rejection.

SUMMARY

In view of the above amendments and remarks, Applicants submit that this application is in condition for allowance. An early and favorable action is earnestly solicited.


Please grant any extensions of time required to enter this amendment and response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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